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### REMARKS

Claims 7-12, 22-27, 37-42, and 48 are currently pending.

In the Office Action, the Examiner rejected claims 7-12, 22-27, 37-42, and 48 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,071,697 to Bushnell et al. ("*Bushnell*") in view of U.S. Patent No. 5,991,310 to Katko ("*Katko*"). Applicants note that the Examiner did not list *Bushnell* on the Examiner's Notice of References Cited that was attached to the Office Action. Applicants request that the Examiner properly cite *Bushnell* on PTO Form 892. Regarding the section 103 rejection, Applicants respectfully traverse.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103, the Examiner must demonstrate that: (1) the prior art references disclose or suggest each and every element recited in the claims; (2) there is a reasonable probability of success of any modification of the teachings of the references, and (3) there exists some suggestion or motivation, either in the teachings of the references themselves or in the knowledge generally available to one of ordinary skill in the art, to make such a modification in a manner resulting in the claimed invention. See M.P.E.P. § 2143 (7th ed. 1998). Furthermore, each of these requirements must be found in the prior art—not based on Applicants' own disclosure. See *id.* Applicants respectfully submit that the Examiner has failed to demonstrate a *prima facie* case of obviousness in this Office Action.

#### *Bushnell* Does Not Teach or Suggest "Bundle Codes" and the Recited "Converting" Operation

Claim 7 recites a method for processing requests for products comprising the steps, performed by a processor, of storing in a database a set of bundle codes, each

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bundle code indicating at least two products offered by at least two different providers, receiving a request identifying a customer and including a bundle code, converting a portion of the received request into at least one specifically-formatted provisioning request for each provider based on the received bundle code, and providing the provisioning requests to the providers to initiate a product supply process by each provider.

In the Office Action ("OA"), the Examiner alleged that *Bushnell* discloses all these recited features except storing in a database a set of bundle codes, each bundle code indicating at least two products offered by at least two different providers. (OA at 3.) In essence, the Examiner argued that *Bushnell* teaches the features recited in the steps of claim 7, but only for a single product. Applicants respectfully disagree.

Among other things, *Bushnell* does not disclose or suggest a "bundle code" or operations concerning a bundle code, including "converting a portion of the received request into at least one specifically-formatted provisioning request for each provider based on the received bundle code," as recited in claim 7. Instead, *Bushnell* discloses a system that allows a user to purchase merchandise from different stores one piece at a time as the merchandise is displayed on a TV. When the user makes a selection, the user's customer station automatically telephones the store that sells the selected product. (E.g., abstract, col. 1, lines 38-41; col. 3, lines 17-35). The customer station decodes information in the transmitted TV signal to identify the telephone number of the store selling the selected merchandise. Once connected, "the called store identifies the calling party by means of a code transmitted as a preamble to the buying information. The code contains the credit card number and telephone number of the caller." (Col. 5,

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lines 6-15.) In addition, "the coded output of computer 38 [in the customer station] representing particular merchandise is passed [to the store computer]." (Col. 5, lines 33-40). The store computer then "registers a request to purchase the selected merchandise," by checking the caller's credit, checking inventory, and authorizing the sale. (E.g., abstract, col. 3, lines 34-40, col. 5, lines 55-63).

First, as the Examiner admits, *Bushnell* does not teach or suggest a "bundle code indicating at least two products offered by at least two different providers." *Bushnell's* TV signal includes data that identifies one product and the one store that is offering the product.

Second, *Bushnell* does not teach or suggest "converting a portion of the received request into at least one specifically-formatted provisioning request for each provider based on the received bundle code." Regarding "register[ing] a request to purchase the selected merchandise" (abstract), *Bushnell* teaches only that "the called store identifies the calling party by means of a code" (col. 5, lines 6-15), and the "the coded output of computer 38 [in the customer station] representing particular merchandise is passed [to the store computer]" (col. 5, lines 33-37). *Bushnell* makes no mention of converting anything into a "specifically-formatted provisioning request for each provider." Instead it merely states that the calling party is identified "by means of a code" and that "coded output" representing the merchandise is sent to the store computer. *Bushnell* does not teach or suggest that specifically-formatted "codes" or "coded outputs" are sent to different stores. *Bushnell* does not teach or suggest formatting provisioning requests for each provider based on the bundle code.

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In the Office Action, the Examiner contended that "[t]he converting step is equivalent to identifying the proper store to send the [purchase request to]." Applicants respectfully disagree. "Identify" means to establish the identity, origin, nature, or characteristics of something, in this case a store. *The American Heritage College Dictionary*, 674 (3d ed. 1997). "Convert" means to change something (in this case, a portion of a received request) into another form; transform. *The American Heritage College Dictionary*, 304 (3d ed. 1997). Establishing the identity of the store selling a selected piece of merchandise is not equivalent to converting a portion of the received request into at least one specifically-formatted provisioning request for each provider based on the received bundle code, as the Examiner contends.

Furthermore, *Bushnell* teaches that a store is identified by its telephone number; "the telephone number of the actual store involved is encoded with the transmitted video data" (col. 5, lines 1-5), and "the page number itself [of the catalog displayed on the TV] can be used as the identification of the store to be called" (col. 5, lines 20-24). The concept of decoding an encoded telephone number or looking up the telephone number associated with a page number as disclosed by *Bushnell* does not teach or suggest "converting a portion of the received request into at least one specifically-formatted provisioning request for each provider" as claim 7 recites. A telephone number is not a provisioning request because it does not request a product for a customer. A telephone number merely helps create a communication connection between two telephones. Furthermore, the telephone number in *Bushnell* is not specifically-formatted for each store; rather the telephone number is in the same format for all stores (e.g., 3-digit area

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code followed by a seven-digit number). And as discussed above, *Bushnell* teaches nothing about the formatting of the coded output for a product sent to a store.

*Katko* Does Not Teach or Suggest a Bundle Code

Among other things, claim 7 recites "storing in a database a set of bundle codes, each bundle code indicating at least two products offered by at least two different providers." The Examiner admits that *Bushnell* does not teach or suggest a bundle code. The Examiner contends that *Katko* teaches a set of bundle codes. (OA at 3.) Applicants respectfully disagree.

*Katko* concerns a technique for bypassing a Local Exchange Carrier (LEC) when making long distance calls by using a wire connection between the long distance exchange (or central office) and the customer premises, thus eliminating the LEC's charges for long distance calls and other local services. (Abstract, col. 4, lines 9-27.)

*Katko* tangentially mentions bundled communications services twice. Neither mention discloses or suggests bundle codes or how to process customer requests for products using bundle codes, each code indicating at least two products offered by at least two different providers. *Katko* merely states: "Through the bundling of communications services such as dial tone, long distance, Internet access, and security system monitoring, such an independent company will be able, using the techniques of the invention, to offer these services in a bundled platform offering a 20% to 30% savings to the consumer over existing services of these types" (col. 4, lines 14-20), and "The subscriber would then receive conventional Central Office bundled services as well as Internet access and security system monitoring at a rate substantially reduced from that currently provided by the LECs" (col. 13, lines 63-67).

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Thus, *Katko* discloses only that companies could offer bundled communications services at a discount by bypassing the LEC and hence the LEC's charges. *Katko* does not teach or suggest a bundle code at all, never mind a bundle code having all the features and functionality recited in claim 7. *Katko* does not disclose the use of any type of code, or even the use of a processor that might use a code for processing customer requests for products. *Katko*, in fact, has not a word about how customer requests are configured or processed.

As the present application points out in describing one embodiment consistent with the invention, because a CLEC provides a wide variety of products and services from a disparate group of telecommunications providers, it incurs significant costs. (Application pg. 2.) It is expensive for a CLEC to coordinate its provisioning operation with the many providers that supply a customer with the customer-selected products. (*Id.*) For example, a customer may select products and services of several different providers, including a company like Verizon for local exchange service (in those areas where Verizon provides local exchange service), AT&T for long distance service, Earthlink for Internet service, Verizon Wireless for wireless cellular service, and Bell South for a cellular phone and power adapter. Typically, each provider will require different "provisioning data" from the CLEC to place an order for a selected product, because each provider's order-processing procedures and order-processing equipment are different. (*Id.*) Additionally, each provider typically requires the provisioning data to be in its own specific format in order to properly process product requests from the CLEC. (*Id.*) Consequently, the CLEC cannot just send one standardized order form to each provider when a customer requests a set of telecommunications products and/or

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services. Instead, the CLEC must determine the different products selected by the customer, then forward the appropriate provisioning data in the appropriate format to each of the selected providers. (*Id.*) Organizing the selected products, determining what provisioning data is required by each provider, and putting the provisioning data into the correct format for each provider are difficult and expensive tasks for the CLEC.

The method recited in claim 7 uses bundle codes to perform these tasks. *Katko*, in contrast, does not disclose how these tasks are performed or how a bundle code could assist in these tasks; it merely discloses that communications services may be bundled. Consequently, *Katko* also does not teach or suggest a bundle code or the operations that use a bundle code, such as "converting a portion of the received request into at least one specifically-formatted provisioning request for each provider based on the received bundle code," as recited in claim 7.

There Is No Suggestion or Motivation to Combine *Bushnell* and *Katko*

In the Office Action, the Examiner asserts that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of *Katko* into *Bushnell* et al in order to allow customers to make a plurality of purchases from a plurality of suppliers in order to provide a discounted price to customers."

Applicants respectfully disagree.

First, *Bushnell* and *Katko* are nonanalogous art that one of ordinary skill would not combine. *Bushnell* concerns a system for purchasing merchandise from stores using a TV set and a computer. (See, e.g., Figs. 1-3). *Katko*, on the other hand, concerns a system for bypassing a local exchange carrier by running wires directly from a customer premise to a central telephone office. (See, e.g., Figs. 1-8). "In order to rely

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on a reference as a basis for rejection of the applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Deminski, 769 F.2d 436,442 (Fed. Cir. 1986). It is difficult to imagine why a skilled artisan seeking to improve *Bushnell's* TV shopping system would consult *Katko's* patent concerning telephone wiring for bypassing a LEC.

Second, *Katko* does not provide a solution that applies to the motivation alleged by the examiner (which motivation Applicants submit is not demonstrated in the Office Action in any case). The Examiner asserts that a skilled artisan would be motivated "in order to allow customers to make a plurality of purchases from a plurality of suppliers in order to provide a discounted price to customers." *Katko*, however, discloses nothing that would help provide a discounted price to customers who make a plurality of purchases from a plurality of suppliers. *Katko's* system provides a discount to customers because it bypasses the LEC and thus avoids the LEC's charges. It doesn't matter how many services the customer purchases or from whom, because the savings come from wiring around the LEC. Thus, a skilled artisan motivated as the Examiner asserts would not look to *Katko* for a solution.

Finally, Applicants respectfully submit that the Examiner's strained combination of *Bushnell* and *Katko* stems from improper hindsight and relies on Applicants' invention and disclosure as the motivation to combine two unrelated references.

### Conclusion

For at least the foregoing reasons, neither *Bushnell* nor *Katko*, whether taken alone or in combination, teach or suggest each and every element of claim 7.



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Furthermore, the Office Action fails to demonstrate a valid suggestion or motivation, either in the teachings of the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine *Bushnell* and *Katko*. Thus, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 for claim 7. Similarly, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 for independent claims 22 and 37, which recite structures and computer code that perform operations similar to those recited in claim 7. And for at least the same reasons, the Examiner has failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103 for independent claim 48, which recites elements that receive customer requests and distribute specifically-formatted provisioning requests to each of the providers to initiate a product supply process by each of the providers, similar to the operations recited in claim 7. Accordingly, Applicants respectfully submit that claims 7, 22, 37, and 48 are allowable and request withdrawal of the rejection under 35 U.S.C. § 103.

Also based on the foregoing arguments, and by virtue of their depending from independent claims 7, 22, and 37, Applicants respectfully submit that claims 8-12, 23-27, and 38-42 are also allowable.

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 07-2339

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Respectfully submitted,

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